

REMARKS/ARGUMENT

The present Response is being filed under a Certificate of Transmission as indicated.

Claims 1-2, 6-7, 24-25 and 35-36 are pending and read on the elected species of FIGS. 1-2.

Claims 1, 2, 6 and 24 have been amended. Claims 3-4, 8-9 and 26 have been withdrawn. To expedite prosecution, claims 5, 10-23 and 27-34 were previously cancelled. Applicants reserve the right to proceed with these cancelled claims in a continuation or divisional application.

Response to Notice of Noncompliant of Nonresponsive Amendment dated 7/1/2009

The Notice of Noncompliant or Nonresponsive Amendment indicates:

The reply filed on March 24, 2009 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s). Amendments to claim 1 are unclear. The terms "first" and "distal" are used interchangeably. The rejections of claim 6 under 35 USC 112 second paragraph have not been overcome. It is noted that the adapter has two posts, the two posts define the ends of the adapter. Therefore, use of language such as "tapered post at the opposite end" render the claim vague and indefinite. See 37 CFR 1.111. Since the above-mentioned reply appears to be bona fide, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

With respect to claim 1, the claim has been amended.

With respect to claim 6, the claim has been amended.

Response to Notice of Noncompliant of Nonresponsive Amendment dated 10/2/2009

The Notice of Noncompliant or Nonresponsive Amendment indicates:

☒ E. Other: Amendments to the claims must be made relative to the immediate prior version of the claims. In the instant application, the prior version of the claims is the amendment filed on 03/24/2009. See 37 CFR 1.121 (c)(2).

The claims have been corrected. Applicants apologize for any inconvenience to the Examiner.

Claim Rejections – 35 USC §112

The rejection of claims 35-36 under 35 USC §112, first paragraph is respectfully traversed. The Examiner indicated that the limitations of "at least 1 inch" and "at least 1.3

inches” were deemed to be new matter. However, in describing the distal femoral component 10A, the specification expressly provides: “The depth of the Morse taper bore 26 may be 1.39 inches for example.” (page 14, line 12). Since 1.39 inches is greater than 1 inch and greater than 1.3 inches, there is express support for these limitations in the specification as filed, and these claims do not add new matter.

The rejection of claims 1-2, 6-7 and 35-36 under 35 USC §112, second paragraph, is respectfully traversed. Referring to the limitation “a tapered bore at the proximal end, the tapered bore being widest at the proximal end” in claim 1, the Examiner indicated that “it is unclear what structural relationship is being claimed by the Applicants.” Claim 1 also calls for the tapered bore to extend “distally from the proximal end.” If a bore is tapered, there must be some portion that is widest, and the bore must taper to a smaller width. Here, by referencing the proximal end, claim 1 is defining how the bore tapers – it is widest at the proximal end and tapers as it extends distally.

Consider FIG. 36 of the present application:

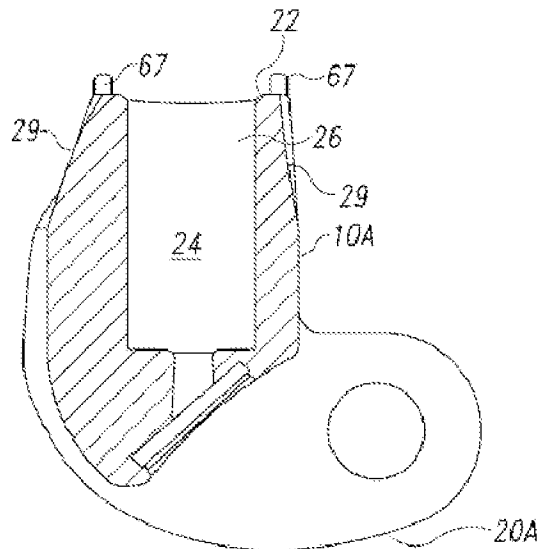


Fig. 36

“The test for definiteness under 35 U.S.C. 112 is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’ [citation omitted]” MPEP §2173.02. Here, anyone of ordinary skill in the art can determine: where the tapered bore is located and where the tapered bore is widest. One does not need to know where the bore ends to know what is claimed; for the purposes of claim 1, the proximal-distal dimension of the tapered bore is irrelevant as long as the bore extends distally from the proximal end.

Accordingly, a proper rejection under 35 U.S.C. §112 has not been met and claim 1 is patentable under 35 U.S.C. §112. Claim 2, which depends on independent claim 1, is therefore also patentable.

With respect to claim 6, claim 6 calls for the first component to have a bore with an opening at the proximal end of the first component. The bore extends distally from the opening. The bore is widest at the opening. Amended claim 6 is believed to meet the requirements of 35 USC §112. Claim 7, which depends on independent claim 6, is therefore also patentable.

With respect to claims 35-36, the dimensions stated identify minimum proximal-distal dimensions of the bore. Again, one of ordinary skill in the art does not need to know the maximum proximal-distal dimension to understand what is claimed.

Accordingly, all of claims 1-2, 6-7 and 35-36 meet the standards of 35 U.S.C. §112.

Claim Rejections – 35 USC §102

The rejection of claims 1-2, 24 and 25 under 35 USC §102(b) as being anticipated by White et al. (US 5,725,592) is respectfully traversed.

First with respect to claim 1, element 112 of White et al. cannot be characterized as a distal femoral component. White et al. characterizes element 112 as a head component. Such a component would comprise a *proximal* femoral (or humeral) implant component, and such an element would not be placed at the distal end of the femur. White et al. teaches:

“Replacing portions of a deteriorated or broken hip or shoulder has become an increasingly frequent operation that surgeons perform. One prosthesis that is commonly used replaces either a portion of the femur that connects with the pelvis or a portion of the humerus that attaches into the glenoid cavity of the shoulder. A variety of these prostheses have been developed, and they can be classified into one of three classifications that are based on the number of components that fit together to form the prosthesis.” (Background of the Invention, col. 1, lines 10-18)

“Neck component 110 has a proximal neck 111 that attaches to a head component 112 which fits into the patient's pelvic socket, or, if desired, the head component may be formed integrally as part of the neck component.” (col. 6, lines 21-23)

The drawings in White et al. illustrate the component 112 as having a substantially spherical or hemispherical shape. Such a component would not be used to replace any portion of the distal femur.

Nor would one consider element 112 to be sized and shaped to replace the distal 3 cm of the native femur, as set forth in dependent claim 2. Accordingly, claims 1 and 2 are patentable over White et al.

Second with respect to independent claim 24, element 110 of White et al., characterized in the Office Action as comprising an adapter with posts 111, 113, does not have posts 111, 113 aligned along a central longitudinal axis of the element. And as

discussed above with respect to claims 1-2, White et al. does not disclose a distal femoral component; the implant of White et al. is a proximal femoral or humeral component. Accordingly, White et al. does not read on claim 24 or its dependent claim 25. Accordingly, claims 24 and 25 are patentable over White et al.

Claim Rejections – 35 USC §103

The rejection of claims 35 and 36 under 35 U.S.C. §103(a) as being unpatentable over White et al. is respectfully traversed. Claims 35 and 36 depend on claim 1. White et al. do not relate to distal femoral implants. If one were to consider the assembly of the elements the Office Action characterizes as the adapter and the second component in White et al. (elements 110 and 120), the assembly would not comprise a metaphyseal sleeve with a tapered post extending out of the widest portion at a distal end and having a central longitudinal axis extending through the proximal end of the metaphyseal sleeve. To the contrary, any central longitudinal axis of post 111 would not intersect the opposite end of element 120.

CONCLUSION

For the above-described reasons it is respectfully submitted that the rejections to the claims that were not canceled or withdrawn have been overcome and that claims 1-2, 6-7, 24-25 and 35-36 are currently in condition for allowance. Reconsideration, further examination and a Notice of Allowance are respectfully requested.

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October 14, 2009

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